

REMARKS

Following entry of these amendments, claims 3, 10, 17 and 21-26 are pending in the above-identified application. In the current Office Action, dated November 23, 2010, (O.A.), claims 3, 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Oizumi et al. (U.S. Pat. No. 7,302,470; hereinafter referred to as “Oizumi”) in view of Gropper et al. (U.S. Pat. No. 7,505,974; hereinafter referred to as “Gropper”).

Applicants submit that these amendments and remarks overcome all of the Examiner’s outstanding objections and rejections and bring the present Application into condition for allowance. Entry of this amendment and a notice of allowance of all the remaining claims are therefore respectfully solicited.

Amendments to the Title

The following Amendment to the Title was first submitted in a Response dated August 26, 2010 but apparently not entered. The Title is amended to remove unnecessary references to particular types of claims. Applicants respectfully request entry of the Amendment to the Title.

Rejections Based Upon 35 U.S.C. §103(a)

Claims 3, 10 and 17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Oizumi in view of Gropper. Claims 3, 10 and 17 have been amended to clarify that Applicants’ indicator is cleared in response to “subsequently receiving an unsolicited e-mail originated from the address of the addressee corresponding to the failed delivery message.” The O.A. concedes that Oizumi does not disclose “clearing said indicator in response to subsequently receiving an e-mail originated from the address of the addressee corresponding to the failed delivery message,” relying upon Gropper for this particular element. The portion of Gropper relied upon states:

11. provides a mechanism whereby the user’s digital address book is automatically updated with the addressees’ **responses to the user’s request(s) for updated contact-related information.**

(col. 2, lines 41-52; *emphasis added*). In other words, Gropper does not suggest any mechanism in which the indicator is automatically updated based upon receipt of an email that is a response to a user request, i.e. “unsolicited.”

New claims 21-26 have been added to focus on additional novel aspects of Applicants disclosed technology, specifically the clearing of the indicator after a period of time and the automatic retransmission of a cached email message in response to the clearing of the indicator. Support for claims 21, 23 and 25 is located in the original claims 2, 9 and 16, which are considered part of the original disclosure and, in the Specification at elements 305 and 307, FIG. 3 and ¶¶[0032]-[0034]. Support for claims 22, 24 and 26 is located in the original claims 5, 12 and 19 and in the Specification at 212, FIG. 2 and ¶¶[0027].

With respect to new claims 21, 23 and 25, rejections of original claims 2, 9 and 19 in an Office Action mailed on March 20, 2007 ('07 O.A.) need to be addressed. In the '07 O.A., claims 2, 9 and 19 were rejected under 35 U.S.C. §102(e) as being anticipated by Sommerer (U.S. Pat. Pub. No. 2002/0143879). The cited portion of Sommerer states:

In an alternative embodiment, once flagged the email application attempts to address messages to the flagged address over a period of time to verify that the address is indeed expired before the address is considered expired.

(¶[0045]). This description is directed to the setting of the flag rather than the clearing of the flag and simply does not suggest a clearing after a predetermined period of time.

“The identical invention must be shown in as complete detail as is contained in the claim.” (MPEP §2131, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). The elements must be arranged as required by the claim ... (MPEP §2131, citing *In re Bond*, 910 F.2d 831, (Fed. Cir. 1990)). In addition, to establish *prima facie* obviousness of a claimed invention under §103(a), all the claim limitations must be taught or suggested by the prior art. (M.P.E.P., §2143.03, citing *in re Royka*, 490 F.2d 981; 180 U.S.P.Q. 580 (CCPA 1974)). In addition, “**All words in a claim must be considered** in judging the patentability of that claim against prior art.” (*Id.*, citing *In re Wilson*, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970);

emphasis added). Applicants believe that the cited art fails to meet this standard. For the reasons above, claims 3, 10 and 17 are allowable over the cited art. In addition, new claims 21-26 are allowable because each depends upon one of the allowable independent claims. Therefore, Applicants respectfully request withdrawal of the §103(a) rejections of claims 3, 10 and 17.

CONCLUSION

In light of the amendments and remarks made herein, Applicants submit that all pending claims are allowable and earnestly solicits notice thereof. Applicants are not conceding in this application that the unamended claims are not patentable over the art cited by the Examiner, as the present claim amendments are only for facilitating expeditious prosecution of the allowable subject matter. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications. It is believed that no fees are due with the filing of this Amendment/Response. However, should any fees be due, the Commissioner is hereby authorized to charge such fees to the deposit account of IBM Corporation, Deposit Account No. 09-0447.

Respectfully submitted,

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